Remarks/Arguments:

Claims 1-3, 6-12 and 15-31 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Reilly (U.S. Patent Number 6,427,164 B1) and Nielson (U.S. Patent Number 6,405,234 B1). Claims 1, 10, and 19-25 have been amended. Claims 1-3, 6-12 and 15-31 are pending. Applicants request reconsideration. In particular, neither Reilly, Nielson, nor their combination disclose or suggest:

> ...a first provider server in which a first e-mail address is <u>maintained as valid</u> in the server...
>
> ...said address change notification deputization service server <u>checks the path taken by the e-mail through the sender's e-mail server, the address change notification deputization service server and either the second provider server or both the first provider server and the second provider server</u> (emphasis added),

as required by Applicants' amended claim 1. Amended claims 10 and 19-25 include similar recitations.

Basis for this amendment may be found, for example, at page 19, lines 15-17 (the client "has not cancelled the contract with the old provider"); page 21, line 10 through page 23, line 16 (describing checking the path taken by the e-mail); and Figs. 1-2. Fig. 2, for example, illustrates the path taken by the e-mail. As shown, for example, 203d indicates the sender's server (corresponding to 130 in Fig. 1), 203c and 203b indicate potential transferring servers (corresponding to first provider server 150 and second provider server 140, respectively, in Fig. 1) and 203a indicates the address change notification deputization service server (corresponding to 110 in Fig. 1). No new matter has been added.

Reilly discloses an e-mail forwarding method. The method includes automatically resending to a new and valid e-mail address an e-mail that was originally sent to an "invalid" e-mail address. (See Reilly column 4, line 47). The new, valid e-mail address is registered with an address server. Therefore, in Reilly, the old e-mail address is "invalid." Accordingly, because the old e-mail address is "invalid," it is no longer maintained <u>as valid</u> in the server. Further, the Office Action

admits that Reilly does not disclose Applicants' checking path information step. Thus, Reilly does not include all the features of claims 1, 10 and 19-25 as amended.

Nielson discloses a method of forwarding an e-mail message to an updated address. Using Nielson's method, after changing e-mail addresses, a recipient registers the new e-mail address in an address change server. A sender who wants to send an e-mail to the recipient can send an e-mail to the address change server requesting the new e-mail address and the address change server replies back to the sender with the requested address. The Office Action argues that this feature of Nielson is the same as Applicants' checking the path taken by the e-mail. However, Nielson's feature is not the same. Specifically, Nielson does not disclose or suggest checking the path taken by the e-mail through the sender's e-mail server (130), the address change notification deputization service server (119) and either the second provider server (140) or both the first provider server (150) and the second provider server (140). Thus, Nielson does not include all the features of claims 1, 10 and 19-25 as amended.

Because neither Reilly nor Nielson nor their combination disclose or suggest these limitations of claims 1, 10 and 19-25, these claims are not subject to rejection under 35 U.S.C. § 103(a) as being anticipated by Reilly and Nielson. Claims 2-3, 6-9, 26 and 29 depend from claim 1; claims 11-12, 15-18, 27 and 30 depend from claim 10; and claims 28 and 31 depend from claim 21. Accordingly, these claims are not subject to rejection under 35 U.S.C. § 103(a) as being anticipated by Reilly and Nielson for at least the same reasons as the claims from which they depend.

Claims 1, 10, 19, 20, and 22-23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The portion of those claims cited as failing to comply with the enablement requirement has been deleted from the claims. Accordingly, these claims are not subject to this rejection.

Application No.: 10/025,805   MTS-3299US
Amendment Dated: December 21, 2006
Reply to Office Action of: October 23, 2006

Claims 1, 10, and 22-23 stand rejected under 35 U.S.C. § 112 as being indefinite. Appropriate amendment has been made to claims 1, 10, and 22-23. Accordingly, these claims are not subject to rejection under 35 U.S.C. § 112.

In view of the amendments and arguments set forth above, the above-identified application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

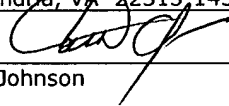Allan Ratner, Reg. No. 19,717
Attorney for Applicant

AR/DK/ds/bj

Dated: December 21, 2006

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.	I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: December 21, 2006.
	Beth Johnson

77411